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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR  | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|-----------------------|---------------------|------------------|
| 10/017.549   | 12/14/2001  | Richard Charles Turek | CL/V-31679A         | 8133             |
| 1095   | 7590        | 12/09/2003            | EXAMINER            |                  |
| THOMAS HOXIE<br>NOVARTIS, CORPORATE INTELLECTUAL PROPERTY<br>ONE HEALTH PLAZA 430/2<br>EAST HANOVER, NJ 07936-1080 |             |                       | PENG, KUO LIANG     |                  |
|  |             |                       | ART UNIT            | PAPER NUMBER     |
|  |             |                       | 1712                |                  |

DATE MAILED: 12/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/017,549

Applicant(s)

TUREK ET AL.

Examiner

Kuo-Liang Peng

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10/20/03 Amendment.
- 2a) ☒ This action is **FINAL**.      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,3-6 and 9-30 is/are allowed.
- 6) ☒ Claim(s) 2 and 7 is/are rejected.
- 7) ☒ Claim(s) 8 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All   b) ☐ Some \*   c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_      6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. The Applicants' amendment filed on October 20, 2003 was received. Claims 1-2, 5, 9, 12-13, 24 and 29-30 are amended.
2. Applicants are right in that in the previous Office Action, paragraph 11, there is a typographical error regarding the sections of Title 35, U.S. code used.

### *Double Patenting*

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claim 2 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 7 of copending Application No. 10/153,040 in view of Heiler (US 6 451 303) and Valint (US 6 193 369).

Claim 7 of the copending Application is directed to an ophthalmic lens comprising a core polymeric material and an ophthalmically compatible surface wherein said core polymeric material comprises at least a color additive of a copper phthalocyanine. Note that the core

material has an oxygen permeability (Dk) of at least 56 barrers. Furthermore, Heiler teaches that a typical contact lens can have an average center thickness of about 0.08 mm (col. 3, lines 17-25). Therefore, it is obvious that the oxygen transmissibility (Dk/t) of the core material in the present invention is at least 60 barrers/mm. Note that Heiler is applied here merely to show a typical center thickness of a contact lens. Furthermore, the component i) and component ii) in Claim 2 correspond to the oxyperm polymerizable materials in the present invention, and the amount of the combination of these two components can be from about 60 to about 70wt%. The component iii) in Claim 2 corresponds to the ionoperm polymerizable material in the present invention, which can be used in an amount of about 30 to 40 wt%. Claim 7 of the copending Application is silent on that the ophthalmically compatible surface surrounding the core being obtained by a surface treatment process. However, Valint teaches a method of surface treating a silicone hydrogel lens. The motivation is to increase wettability and resistance to the formation of deposits during wearing. (col. 2, lines 35-48 and Example 2). In light of the benefit mentioned, it would have been obvious to one of ordinary skill in the art at the time of invention to provide an ophthalmically compatible surface of ophthalmic lenses using Valint's method. Especially, note that Valint's disclosure is in the same field as that of the inventor's endeavor.

This is a provisional obviousness-type double patenting rejection.

5. Claim 7 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 7 of copending Application No. 10/153,040 in view of Heiler (US 6 451 303).

As mentioned above, Claim 7 of the copending Application is directed to an ophthalmic lens comprising a core polymeric material and an ophthalmically compatible surface wherein said core polymeric material comprises at least a color additive of a copper phthalocyanine. Therefore, Claim 7 of the copending Application obviously reads on Claim 7 of the present invention.

This is a provisional obviousness-type double patenting rejection.

***Responsive to arguments regarding double patenting***

6. Applicant's arguments filed on October 20, 2003 have been fully considered but they are not persuasive.

*The Applicants' principal argument against the rejection is that "the commonly assigned copending application No. 10/153,040 has an effective filing date of November 8, 2001, later than the effective filing date (JANUARY 5, 2001) of the present application." (Remarks, 3<sup>rd</sup> paragraph).*

Applicants should notice that the effective filing dates are irrelevant when considering double patenting.

***Allowable Subject Matter***

7. Claims 1, 3-6 and 9-30 are allowed.

8. The following is an examiner's statement of reasons for allowance:

The present claims are allowable over the closest references: Covington (US 4 423 195), Lally (US 6 149 842), Hendrickson (US 5 106 533).

None of Covington, Lally and Hendrickson teaches or fairly suggests an ophthalmic molding having an oxygen transmissibility and comprising the polymer matrix as set forth in the present invention.

9. Claim 8 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The patentability of the instant claim is described in the previous paragraph. Note that Claim 8 is not rejected under obvious type double patenting by Copending Application 10/153,040 because a copper phthalocyanine pigment can have various colors, such as blue, green, etc.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuo-Liang Peng whose telephone number is (703) 306-5550. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on (703) 306-2777. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

klp  
December 2, 2003

  
Kuo-Liang Peng  
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